

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action of the Examiner mailed October 15, 2008. Currently, claims 1-36 remain pending. Claims 1-36 have been rejected. In this amendment, claims 1, 4, 6, 12, 14, 16, 22, 25, and 31-36 have been amended and claims 5, 7, 15, 17, and 26 have been canceled. Support for the amendments can be easily identified in the drawings, specification, and canceled claims. Claims 1-4, 6, 8-14, 16, 18-25, and 27-36 remain pending. Favorable consideration of the above amendments and the following remarks is respectfully requested.

Claim Rejections – 35 USC § 102

Claims 1, 4-11, 22, and 25-36 stand rejected under 35 U.S.C. §102(b) as being anticipated by Vale et al. (U.S. Publication No. 2002/0058963). In this amendment, claims 5, 7, and 26 have been canceled, rendering their rejection moot. After careful review, Applicants must respectfully traverse the rejection of claims 1, 4, 6, 8-11, 22, 25, and 27-36.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP 2131).

Turning to claim 1, which recites:

1. (Currently Amended) A medical device, comprising:
an elongated tubular member having a proximal segment, a distal segment, and an inner lumen disposed at least partially therethrough; and
a dilator tip ~~eatheter~~ having a proximal end insertable at least in part within the distal segment, a proximal section, a distally-tapered distal section, a raised ridge between the proximal section and the distal section, and an inner lumen disposed therethrough;

wherein [[a]] the proximal section of the dilator tip eatheter has an outer diameter and the distal segment of the elongated tubular member has an inner diameter smaller than the outer diameter of the proximal section of the dilator tip eatheter;

wherein [[a]] the proximal end of the dilator tip eatheter is positioned at least in part within the distal segment of the elongated tubular member such that the distal segment expands around at least a portion of the proximal section of the dilator tip eatheter.

Vale et al. do not appear to disclose each and every element of the claimed arrangement of a dilator tip having a proximal section, a distal section, and a raised ridge between the proximal and distal sections where the distal segment of the elongated tubular member has an inner diameter smaller than the outer diameter of the proximal section and where the distal segment expands around at least a portion of the proximal section of the dilator tip. Accordingly, Applicants submit that Vale et al. cannot anticipate claim 1. Since claims 4, 6, and 8-11 depend from claim 1 and add additional elements thereto, Applicants submit that these claims are also not anticipated by Vale et al. Withdrawal of the rejection is respectfully requested.

Independent claim 22 contains similar limitations to claim 1, and Vale et al. also appear to be unable to provide the claimed interference fit of claim 22. Claims 31-33 also contain limitations that are similar to claim 1. Given that Vale et al. do not appear to disclose each and every element of the claims, Vale et al. are not believed to anticipate independent claims 22 and 31-33. Since claims 25, 27-30, and 34-36 depend from claims 22 and 33 and add additional elements, claims 25, 27-30, and 34-36 are also not believed to be anticipated by Vale et al. Applicant respectfully requests withdrawal of the rejection.

Claim Rejections – 35 USC § 103

Claims 2 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vale et al. (U.S. Publication No. 2002/0058963) in view of Nilsson (U.S. Patent No. 5,873,851). Applicants respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03).

For at least the same reasons given above, claims 2 and 23, which depend from claims 1 and 22 and include additional limitations, are believed to be patentable over Vale et al. Nilsson does not appear to remedy the shortcomings of Vale et al. Applicants respectfully request that the rejection be withdrawn.

Claims 3, 12, 14-21, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Vale et al. in view of Salahieh et al. (U.S. Publication No. 2004/0127936). In this amendment, claims 15 and 17 have been canceled, rendering their rejection moot. After careful

review, Applicants must respectfully traverse the rejection of claims 3, 12, 14, 16, 18-21, and 24.

Similar to claim 1 above, Vale et al. do not appear to disclose all elements of independent claim 12. Vale et al. do not appear to disclose the claimed arrangement of a dilator tip having a proximal section, a distal section, and a raised ridge between the proximal and distal sections where the proximal section of the dilator tip urges the distal segment of the elongated tubular member into a radially expanded state. Salahieh et al. do not appear to remedy the shortcomings of Vale et al. Accordingly, claim 12 is believed to be patentable over Vale et al. and Salahieh et al.

Since claims 3, 14, 16, 18-21, and 24 depend from claims 1, 12, or 22, which are believed to be allowable, and add additional elements thereto, claims 3, 12, 14, 16, 18-21, and 24 are also believed to be patentable over Vale et al. and Salahieh et al. Withdrawal of the rejection is respectfully requested.

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Vale et al. in view of Salahieh et al. as applied to claim 12, and further in view of Nilsson. As discussed above, neither Salalieh et al. nor Nilsson appear to remedy the shortcomings of Vale et al. Since claim 12 is believed to be allowable over Vale et al. and Salalieh et al, Applicants submit that claims 13 is also allowable and respectfully request that the rejection be withdrawn.

Response to Examiner's Comments

Applicants acknowledge the Examiner's comments regarding the definition of the term "dilator tip catheter". Applicants remind the Examiner that "the words of the claim must be given their plain meaning unless **>the plain meaning is inconsistent with< the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)". "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, *>415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326< (Fed. Cir. 2005) (*en banc*). *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)(“In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the

ordinary and customary meanings attributed to them by those of ordinary skill in the art.”). (MPEP 2111.01).

Applicants take this to mean that absent a specific definition in the specification, the term “dilator tip catheter” should be given a meaning consistent with one that would be attributed by one of ordinary skill in the art, not the interpretation of the Examiner. The feature asserted by the Examiner to be a “dilator tip catheter” (ref. #71 in Figure 27 of Vale et al.) is in fact disclosed to be a “distal embolic filter” (see paragraphs 101-104). However, in the interest of furthering prosecution, Applicants have removed the word “catheter” from this claim term throughout the pending claims.

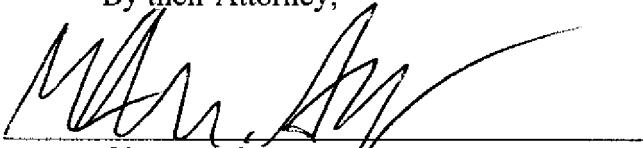
Conclusion

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,



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